

REMARKS/ARGUMENTS

Favorable consideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 12, 18 and 21-22 are pending in the application, with Claims 12 and 21-22 amended by the present amendment. Claims 12 and 21-22 are amended to correct typographical errors found in Applicants' response of June 9, 2006. The following remarks are repeated from Applicants' response of June 9, 2006, albeit updated to reflect the present amendments to Claims 12 and 21-22.

In the outstanding Office Action, Claims 9-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakamura et al. (U.S. Patent No. 5,740,168) in view of Hamalainen (U.S. Patent No. 6,148,209).

Applicants note the present application is the subject of a Petition to Make Special. Thus, Applicants request expedited handling of this application.

Applicants acknowledge with appreciation the personal interview between the Examiner, the Examiner's supervisor, and Applicants' representatives on January 19, 2006 regarding co-pending application 10/796,092. As discussed during the interview, independent Claims 12 and 18 are amended to clarify that the completion message is sent from the mobile to a base station or a base station controller as disclosed in Applicants' originally filed specification.<sup>1</sup> No new matter is added.

Briefly recapitulating, independent Claims 12 and 18 are directed to corresponding communications systems and method. In particular, Claim 12 is directed to a radio communication method for a radio communication system employing CDMA (Code Division Multiple Access) for radio access and providing multi-rate transmission, the radio communication system including a base station controlling apparatus, a plurality of base

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<sup>1</sup> Specification, page 26, line 23 through page 29, line 29.

stations, and a plurality of mobile stations. The radio communication method includes the steps of: informing, by the base station controlling apparatus or by the one of the plurality of base stations, one of the plurality of mobile stations, that a first code being used by the one of the plurality of mobile stations is to be switched to a second code; transmitting timing information by message to the one of the plurality of mobile stations, the timing information regarding timing of switching the first code to the second code; switching the first code to the second code at the one of the plurality of mobile stations, the step of switching the first code based on the step informing and on the transmitted timing information; switching a spreading code from the first code to the second code at the one of the plurality of base stations in synchronization with switching the first code to the second code at the one of the plurality of mobile stations, and transmitting a completion message from the one of the plurality of mobile stations to indicate completion of the step of switching a spreading code from the first code to the second code at the one of the plurality of mobile stations. The invention ensures accurate synchronization of the base station and mobile.<sup>2</sup>

Nakamura describes a method for code switching, including the transmission of a timing signal from a base station to a mobile station.<sup>3</sup> However, Nakamura does not disclose or suggest sending a base channel completion message after receiving a completion message (indicating the release of the first code). As noted during the interview and as acknowledged by the Examiners, Nakamura only discloses registering the completion of switching from one code to another code in an internal (not external) controller.<sup>4</sup> Because Nakamura is explicit about where the completion message is sent, Applicants submit that Nakamura teaches away from Applicants' claimed invention of sending a completion message from a mobile station either to a base station or a base station controlling apparatus. Thus, Nakamura fails to disclose or suggest "transmitting a completion message to indicate completion of the step of

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<sup>2</sup> Specification, paragraphs 121-128.

<sup>3</sup> Nakamura, Figures 420B and 25.

<sup>4</sup> Nakamura column 7, lines 4-15.

switching a spreading code from the first code to the second code at the one of the plurality of mobile stations” as recited in Claims 12 and 18.

Furthermore, Nakamura does not disclose or suggest Applicants’ claimed base station controlling apparatus. That is, Nakamura only discloses a base station and a mobile station. Nakamura does not disclose or suggest a base station controlling apparatus separate from a plurality of base stations, as recited in Applicants’ claims.

Also during the interview, U.S. Patent No. 6,148,209 to Hamalainen et al. (hereinafter Hamalainen) was discussed. While Hamalainen was not of record in the present application at the time of the interview, Hamalainen had been cited in Applicants’ copending application 10/796,090. During the interview, Applicants’ representatives noted that neither Hamalainen nor Nakamura disclose or suggest sending a code switching message from a mobile to a base station or a base station controller. As noted above and during the interview, Nakamura only discloses reporting the completion of switching from one code to another code to an internal (not external) controller.<sup>5</sup> Because Nakamura is explicit about where the completion message is sent, Applicants submit that Nakamura teaches away from Applicants’ claimed invention of sending a completion message from a mobile station either to a base station or a base station controlling apparatus. Thus, Applicants submit that modifying Nakamura to be able to send a completion message to an external device (e.g., a base station or a base station controlling apparatus) is an improper hindsight reconstruction of Applicants’ invention.

Furthermore, as discussed during the interview, Hamalainen does not disclose or suggest sending a code switching completion message of any kind, let alone a sending a code switching message from a mobile station to a base station or a base station controlling apparatus. Hamalainen only describes the sending of a time slot assignment

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<sup>5</sup> Nakamura column 7, lines 4-15.

acknowledgement message.<sup>6</sup> Hamalainen makes no reference to switching of codes or the reporting of a completed code switching. Applicants submit that equating the time slot assignment acknowledgement message of Hamalainen with Applicants' claimed code switching completion message is an improper hindsight reconstruction of Applicants' claimed invention. Thus, assuming *arguendo* that the combination Nakamura and Hamalainen is proper, the combination of Nakamura and Hamalainen does not disclose or suggest Applicants' claimed feature of sending a code switching completion message from a mobile to a base station or a base station controlling apparatus.

Furthermore, like Nakamura, Hamalainen does not disclose or suggest Applicants' claimed base station controlling apparatus. That is, Hamalainen only discloses a base station and a mobile station. Hamalainen does not disclose or suggest a base station controlling apparatus separate from a plurality of base stations, as recited in Applicants' claims.

MPEP §706.02(j) notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without addressing the first two prongs of the test of obviousness, Applicants submit that the Official Action does not present a *prima facie* case of obviousness because both Nakamura and Adachi fail to disclose all the features of recited in Applicants' claimed invention.

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<sup>6</sup> Hamalainen column 7, lines 20-26.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicant respectfully submits that the present application is in condition for allowance and respectfully requests an early and favorable action to that effect.

Respectfully submitted,

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